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10/821,405	04/09/2004	Miles Paschini	EWIR-001/02US 300933-2005	8429
23419 7590 11/23/2009 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001			EXAMINER COPPOLA, JACOB C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,405	Applicant(s) PASCHINI ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 10-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to amendments to the claims and remarks filed on 14 July 2009 (“09 July Response”).
2. Claims 1-39 are currently pending.
3. Claims 1-9 and 31-39 have been examined.
4. Claims 10-30 were withdrawn in the Office action mailed on 14 January 2009 (Paper No. 20090110).
5. This Office Action is given Paper No. 20091115. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC §112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4, 32-34, and 38 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claim 4

8. Claim 4 recites “wherein at least one of said plurality of servers is configured to send PINs to said hub in anticipation of going offline.” Claim 4 is indefinite because it is unclear

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what time frame or trigger constitutes being “in anticipation of.” Additionally, it is unclear what particular structure is required to anticipate, or render obvious, claim 4.

Regarding Claims 32-34

9. Claim 31 recites “generating... a request for a PIN” and “receiving... a client request for said PIN, wherein said client request is generated at said client terminal....” Accordingly, claim 31 appears to have two requests generated, the request for the PIN and the client request.

10. Claims 32-34, which depend from claim 31, recite “said generating is initiated in response to a PIN inventory.”

11. Claims 32-34 are indefinite because it is unclear whether “said generating” is referring to the generated request for the PIN or the generated client request.

Regarding Claim 38

12. Claim 38 recites “receiving, at said server, a request for an additional PIN generated at said hub.” Claim 38 is indefinite because it is unclear what item is “generated at said hub,” the “PIN” or the “request.”

13. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-5, 7-9, and 31-39, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over White et al. (U.S. 6,169,975 B1) (“White”), in view of Bullen et al. (U.S. 7,197,662 B2) (“Bullen”).

Regarding Claim 1

16. White discloses:

a plurality of client terminals (“terminal devices **110**”), each of said plurality of client terminals being capable of requesting and receiving PINs (c. 6, l. 8-33; and c 8, l. 39-52); and

a plurality of servers operatively coupled to said plurality of client terminals (“one or more host computer systems **601**”), each of said servers including a corresponding one of a plurality of PIN inventories, wherein each of said servers is capable of sending PINs to at least one of said plurality of client terminals (c. 6, l. 8-33; and c. 8, l. 39 – c. 9, l. 48).

17. White does not directly disclose:

a hub operatively coupled to each of said servers, wherein said hub is configured to send PINs to each of said plurality of servers for inclusion within said PIN inventories.

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18. Bullen, however, teaches the limitations:

a hub (“hub **10**”) operatively coupled to each of a plurality of servers (“server **12-1**” and “server **12-2**”), wherein said hub sends data to each of said plurality of servers for inclusion within a memory of each server.

19. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of White the hub as taught by Bullen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the network of White to include the hub (which clearly delivers data to servers) of Bullen in order to deliver White’s PINs to White’s servers. One would have been motivated to do so because the hub of Bullen provides a convenient way to provide data (*i.e.*, nonfunctional PINs which are equivalent to the data of Bullen) to a plurality of servers.

Regarding Claims 2-5, 7-9, 36, and 37

21. The combination of White and Bullen discloses the limitations of claim 1, as described above, and further discloses the limitations of:

Claim 2: The system of claim 1 wherein said plurality of servers are geographically dispersed (White, c 7, l. 9-12);

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Claim 3: The system of claim 1 wherein each of said plurality of servers is configured to send PINs to said hub (White, c. 6, l. 8-33 and c. 8, l. 39 – c. 9, l. 48 for each server configured to send PINs; Bullen, at least c. 5, l. 15-50 for each server configured to send data to hub);

Claim 4: The system of claim 3 wherein at least one of said plurality of servers is configured to send PINs to said hub in anticipation of going offline (White, c. 6, l. 8-33; and c. 8, l. 39 – c. 9, l. 48);

Claim 5: The system of claim 1 wherein said hub is configured to request a quantity of PINs from at least one of said plurality of servers in response to another of said plurality of servers requesting at least said quantity of PINs (Bullen, c. 5, l. 15-50);

Claim 7: The system of claim 1 wherein said hub includes a central PIN inventory including a plurality of PIN varieties (White, c. 6, l. 8-33; and c. 8, l. 39 – c. 9, l. 48; and Bullen, memory section **30**);

Claim 8: The system of claim 7 wherein said hub is configured to distribute PINs in said central PIN inventory to at least one of said plurality of servers in advance of said hub going offline (Bullen, c. 5, l. 10+);

Claim 9: The system of claim 1 wherein each of said plurality of servers tracks a quantity of at least one of a plurality of PIN varieties and requests additional quantities of said at least one of said plurality of PIN varieties in response to said quantity of said at least one of said plurality of PIN varieties falling below a low-watermark (White, c. 2, l. 61+);

Claim 36: The system of claim 1, wherein the hub comprises a server communication manager (see Bullen, “Management Complex,” c. 7, l. 5+) which sends said data (*e.g.*, PINs of White) to each of said plurality of servers for inclusion within said PIN inventories (each server

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of White holds a PIN inventory), and which sends a request to at least one of said plurality of servers for PINs included within one of said PIN inventories (see White, c. 2, l. 61+ for PIN requests from one computer to another, predictable to apply this to hub of Bullen which makes data available for all connected servers); and

Claim 37: The system of claim 1, a first client terminal of the plurality of client terminals, wherein the first client terminal receives a first PIN (see rejection to claim 1); and a printing element at the first client terminal, wherein the printing element prints the first PIN on a receipt (White, fig. 11 with associated text).

Regarding Claim 31

22. White discloses:

receiving, at a server, a client request for a PIN, wherein said client request is generated at said client terminal and transmitted to said server (c. 6, l. 8-33; and c. 8, l. 39 – c. 9, l. 48); and sending said PIN to said client terminal in response to said client request (c. 6, l. 8-33; and c. 8, l. 39 – c. 9, l. 48).

23. White does not directly disclose:

generating, at a server, a request for a PIN;

transmitting said request for said PIN from the server to a hub; and

receiving said PIN at said server from said hub.

24. Bullen teaches:

generating, at a server, a request for data (c. 4, l. 4-18);

transmitting said request for said data from the server to a hub (c. 4, l. 4-18); and

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receiving said data at said server from said hub (c. 4, l. 4-18).

25. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the method of White the hub and method as taught by Bullen since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

26. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of White to include the method of Bullen's servers and hub in order to deliver White's PINs to White's servers. One would have been motivated to do so because the method of Bullen provides a convenient way to provide data (*i.e.*, nonfunctional PINs which are equivalent to the data of Bullen) to a plurality of servers.

Regarding Claims 32-35, 38, and 39

27. The combination of White and Bullen discloses the limitations of claim 31, as shown above, and further discloses the limitations of:

Claim 32: The method of claim 31 wherein said generating is initiated in response to a PIN inventory of said server not having said PIN (White, c. 2, l. 61+);

Claim 33: The method of claim 32 wherein said generating is in advance of the receiving of said client request at said server (White, c. 2, l. 61+);

Claim 34: The method of claim 33 including: receiving, at said server, a hub request for another PIN, wherein said hub request is generated at said hub and transmitted to said server; and

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sending said other PIN to said hub (White, c. 2, l. 61+ for PIN requests from one computer to another; Bullen, c. 3, l. 58+ for terminals requesting data from servers, and c. 5, l. 15+ for hub to server communication);

Claim 35: The method of claim 31 including: sending, in advance of going offline, PINs in a PIN inventory at said server to said hub (White, c. 2, l. 61+);

Claim 38: The method of claim 31 including: receiving, at said server, a request for an additional PIN generated at said hub (White allows for multiple PIN requests, see c. 6, l. 8-33 and c. 8, l. 39 – c. 9, l. 48; see c. 2, l. 61+ for PIN requests from one computer to another, predictable to apply this to hub of Bullen which makes data available for all connected servers); and

Claim 39: The method of claim 31 including: printing, at the client terminal, the PIN on a receipt, wherein the PIN is unique in relation to other PINs received at the client terminal (White, fig. 11 with associated text).

28. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of White and Bullen, in further view of Applicants' Own Admission ("AOA") (see arguments below).

Regarding Claim 6

29. The combination of White and Bullen discloses the limitations of claim 1, as described above.

30. The combination of White and Bullen does not directly disclose:

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wherein said hub includes a central dealer database and each of said plurality of servers includes a corresponding one of a plurality of dealer databases, and wherein said hub is configured to synchronize said central dealer database with said plurality of dealer databases so that each of said plurality of dealer databases includes substantially current dealer information.

31. AOA discloses a hierarchical server system employing synchronization to files common among a domain of servers is old and well-known in the art because it maintains assurance to the users of the domain that data is consistent.

32. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to apply this old and well-known practice to the system of White and Bullen in order to maintain data consistency.

Claim Interpretation

33. With respect to the pending claims, the Examiner maintains his interpretation of “PINs” as communicated in ¶¶ 24-26 of the previous Office action mailed on 14 January 2009 (Paper No. 20090110). Additionally, Applicants are again respectfully reminded that data not functionally related to the computer memory on which it is stored will not differentiate a claimed computer from the prior art.¹

34. With respect to new claim 36, the limitation “a server communication manager which sends said data to each of said plurality of servers for inclusion within said PIN inventories, and which sends a request to at least one of said plurality of servers for PINs included within one of said PIN inventories” is not given patentable weight because it does not further limit the

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structure of the system of claim 1. This limitation is a purely functional limitation that does not limit the structure of claim 36 and thus does not distinguish the claimed system over the prior art. See MPEP §2114. This applies to the other functional language of claims 1-9, 36, and 37. For example, claim 37 recites “wherein the printing element prints the first PIN on a receipt.”

35. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

36. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims (*i.e.* claims 1-9 and 31-39) do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

37. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.² Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

¹ *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), and *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); and MPEP 2106.01 II.

² While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

- a. **capable** *adj.* “2. Having the ability required for a specific task or accomplishment; qualified.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;
- b. **offline** “2. In reference to one or more computers, being disconnected from a network.” Computer Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002;
- c. **operative** *adj.* “3. Engaged in or concerned with physical or mechanical activity.” The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000.

Double Patenting

38. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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39. A timely filed terminal disclaimer in compliance with 37 C.F.R. §§ 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

40. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

41. Claims 1-9 and 31-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/821,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims share common elements differing only in terminology.

42. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

35 U.S.C. §112, Second Paragraph

43. Applicants argue:

Applicant respectfully disagrees, because the term “in anticipation of going offline” is supported by the specification.

See p. 6, 09 July Response.

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44. This argument is not persuasive because it is improper to import limitations from the specification into the claims. See MPEP §2111.01 II.

45. Applicants argue:

Applicant respectfully notes that claim 31 includes only one “generating” step to which claims 32-33 refer, and that step includes “generating, at a server, a request for a PIN.”

See p. 6, 09 July Response.

46. The Examiner respectfully disagrees. Claim 31 also includes a request that is generated at the client terminal. Accordingly, it is unclear whether “said generating” is referring to the “generating” or the “generated.”

47. Applicants argue “Applicant also respectfully notes that claim 34 does not recite ‘said generating.’” See p. 7, 09 July Response. The Examiner respectfully disagrees. Because each dependent claim contains the limitations of its base claim, claim 34 contains the limitations of claim 33, which includes “said generating.”

Prior Art

48. Applicants argue:

Applicant respectfully submits that the Bullen disclosure does not even mention a PIN, let alone a hub that is “configured to send PINs to each of said plurality of servers for inclusion within said PIN inventories” as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

See pp. 7 and 8, 09 July Response (emphasis in original).

49. The Examiner respectfully disagrees.

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50. First, the Examiner notes that the above rejection does not assert that the Bullen disclosure does mention a PIN.

51. Second, the claimed system cannot be distinguished over the prior art on the basis of nonfunctional descriptive data (*i.e.*, the “PINs”), see §Claim Interpretation above.

52. Third, this argument is against the references individually. In response to Applicants’ arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

53. Applicants argue:

Applicant respectfully submits that the White disclosure, as correctly acknowledged by the Examiner, does not teach a hub, let alone multiple servers that *send PINs to a hub* as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

See p. 8, 09 July Response (emphasis in original).

54. The Examiner respectfully disagrees. Again, Applicants are arguing against the references individually. This is insufficient in overcoming an obviousness rejection, see above. Bullen’s servers are configured to send data (*i.e.*, nonfunctional PINs) to a hub. This ability could be applied to the server of White.

55. Applicants argue:

Applicant respectfully submits that the Bullen disclosure does not even mention a PIN, let alone the generation of a request for a PIN at a server, the transmission of the request for the PIN from the server to a hub, and the receipt of the PIN at the server from said hub as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

See p. 8, 09 July Response (emphasis in original).

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56. First, the Examiner notes that the above rejection does not assert that the Bullen disclosure does mention a PIN.

57. Second, this argument is against the references individually. This is insufficient in overcoming an obviousness rejection, see above.

58. Applicants argue:

Applicant respectfully submits that the White disclosure, as correctly acknowledged by the Examiner, does not teach a hub, let alone a *hub that transmits a request for a PIN* to a server as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

See p. 8, 09 July Response (emphasis in original).

59. The Examiner respectfully disagrees. First, this argument is against the references individually. This is insufficient in overcoming an obviousness rejection, see above. Second, White teaches the ability for a computer to request a PIN from a second computer. It is predictable to apply this teaching to the hub of the hub/server/terminal structure of the *combined references* because the hub of Bullen is designed as a central storage facility to make data accessible to the adjoined servers.

Official Notice

60. Applicants' attempt at traversing the Official Notice findings as stated in the previous Office action (Paper No. 20090110, ¶ 21w) is inadequate. Adequate traversal is a two step process. First, Applicants must state their traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires Applicants to specifically point out the supposed errors in the Office action, Applicants must state *why* the Official Notice statements are not to be considered common knowledge or well known in the art.

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61. In this application, Applicants have not met step (1) or step (2) because Applicants have failed to clearly state a traversal to the Official Notice statements and have failed to argue *why* the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

Conclusion

62. Applicants' amendments filed in the 09 July Response (at least the addition of new claims) necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

63. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written

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description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

64. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

65. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

66. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
November 15, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621